



BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court is found on pages 11-20 of the record and in 49 Fed. Sup. 576. The opinion of the First Circuit Court of Appeals is included in the record sent to this Court (pp. 213, 221), and appears in 60 United States Patents Quarterly, page 311. Its second opinion accompanies the record at the end thereof.

Jurisdiction.

The grounds upon which jurisdiction is invoked is included in the foregoing Petition for Writ of Certiorari. See case of *Goodyear v. Ray-O-Vac*, 60 U. S. P. Q. 386.

The date of the decision to be reviewed is February 4, 1944, and a second opinion of March 17, 1944. A petition for rehearing was filed February 16, 1944 and denied February 24, 1944. A Motion to Reconsider the Denial of Plaintiff's Petition for Rehearing was filed March 3, 1944 and denied March 17, 1944 with an opinion.

Concise Statement.

The material facts necessary to an understanding of the reasons relied upon for allowance of the writ are contained in the foregoing petition.

Argument.

The *Cuno v. Automatic* case, 314 U. S. 84, 62 S. Ct. Rep. 37, with its statement that the new device "must reveal the flash of creative genius" (p. 91) is being used by some

Federal courts as a ground for revamping the fundamentals of patent law, and quite unjustifiably it seems to counsel for petitioner, especially in view of the recent decision and opinion in *Goodyear v. Ray-O-Vac*, *supra*. Not all of the Circuit Courts of Appeals are doing that. The 2nd Circuit Court of Appeals in *Gold Seal v. Westerman*, 133 F. (2d) 192, still insists that the assailant of the patent must furnish the evidence of invalidity of the patent. It does not interpret the *Cuno v. Automatic* case, *supra*, as changing the fundamental law.

The law still prevailing in that circuit was stated by Justice Stone in *Smith v. Hall*, 301 U. S. 216, 57 S. Ct. Rep. 711, who, in discussing prior art evidence, said:

“They support the heavy burden of persuasion which rests upon one who seeks to negative novelty in a patent by showing prior use. See *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 7, 55 S. Ct. 928, 930, 79 L. Ed. 163, and cases cited.”

Also the *Cuno v. Automatic* flash of genius test was specifically rejected in *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.* by the C. C. A., 7th Circuit judges in 132 F. (2d) 812, 817.

In the instant case the district court judge had a Request for Ruling of Law presented to him by the patentee and thereupon he specifically denied that the burden of proving a patent is invalid is upon the defendant. That Request for Ruling of Law is on page 25 of the record, and is No. 1. The denial is on page 35. It was appealed from (p. 26), and the lower court was affirmed. Furthermore, the First Circuit Court holds that the method claims of the patent are invalid.

“in the *absence* of evidence that the art was waiting impatiently for his contribution we cannot say that invention is unmistakably indicated thereby” (p. 220).

although it concedes that

“We admit that the idea of supporting thin metal while striking a piece out of its edge was, so far as the record in this case is concerned, new with Bellavance” (p. 219),

and it calls the Bellavance method “ingenious and a step forward in the art of making bracelets” (p. 219).

Not only has the First Circuit Court decided that the burden of proving a patent invalid no longer rests on the assailant, thereof; but also that the patentee has the burden of proving by evidence that the art was waiting impatiently for his contribution. And for its authority for this new and extreme law it cites *Cuno v. Automatic*, *supra*.

What is the law? Is the Second Circuit right in holding a patent must be proved invalid by evidence or is the First Circuit right that no evidence or judicial knowledge is required to hold a patent invalid, and that the burden of proving validity rests upon the patentee himself.

Tremendous confusion has resulted from this decision and from the various interpretations placed upon the *Cuno v. Automatic* case, *supra*. Law magazines and the Journal of the Patent Office Society have printed article after article, discussing the *Cuno v. Automatic* case, the authors drawing radically different conclusions therefrom. The second opinion of the First Circuit Court of Appeals in the instant case is still another view of that case and said First Circuit Court admittedly finds itself confused.

On January 18, 1944 in the case of *Potts, et al. v. Coe*, Com'r. of Patents, 60 U. S. P. Q. 226, Advance Sheets, Judges Thurman Arnold and Miller of the Court of Appeals, District of Columbia, held that the burden of proof of patentability is on applicant and that the applicant's oath is no longer a *prima facie* showing of invention even if an article is novel. On page 233 they said:

“The burden of proof of patentability is on the applicant. Prior to the development of corporate research the circumstances under which the alleged invention was made were ordinarily not examined. The oath of the applicant was considered as a sufficient *prima facie* showing of invention provided the article itself was sufficiently novel.”

The case of *Cuno v. Automatic, supra*, is cited in support of this new law concerning invention (p. 229). Is this change in the law authorized? It is similar to the change that the First Circuit Court of Appeals has made in the instant case concerning a patent, namely, thrown upon the patentee the burden of proving his patent is valid. Even though the invention is “ingenious and a step forward” (Opinion p. 220) as the Circuit Court said in this case, still it is invalid until proved valid by “evidence that the art was waiting impatiently” for the patentee’s invention (p. 220).

“Ingenious” means, according to Funk & Wagnalls College Standard Dictionary:

“Possessed of or manifesting inventive faculty.” Here we have a situation where a method is inventive, that is, “ingenious”; but not patentable. Is the law to continue to be that harsh? Shall every lower court’s hand be turned against the patentee inventor?

The First Circuit Court of Appeals has fabricated the prior art from its *belief* alone. It conceives, in its imagination, a journeyman who would think to do what the patentee Bellavance did, although this is just what the journeyman in the jewelry field failed to do. When did their journeyman become so skilled? Under the statute the patentee is entitled to know that date and he has a right to carry the date of his invention back of the filing date. This statute is U. S. Code, title 35, section 69, reading as follows:

“And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used.”

Mr. Bellavance can carry his date of conception of his method back of his filing date, and since he is not a manufacturer himself he isn't limited by any statutory bar of public use in proving an early date.

This goes to show how unfair and unlawful it is for the First Circuit Court to rely on what it imagines a journeyman would do without giving the patentee the date such a journeyman existed. It deprives the patentee of his chance under the law, as stated in Walker on Patents, 6th edition, section 553:

“But the plaintiff may meet the defendant's evidence of anticipating matter by proof that he, or his assignor, made the invention at a still earlier date.”

There are statements in the First Circuit Court's opinion that are incorrect, and these should be noted. First of all there is more to the patented method as set forth in claims 2, 3 and 4 of the Bellavance patent (pp. 120, 121), than merely “supporting the lateral faces of said flanges at points adjacent to the struck down portions” (Rec. p. 219). The claim is specific. Claim 2, which the court discusses in detail, is confined to a method of forming a bracelet structure, and to the steps of shaping metal stock to form a curved section having lateral flanges, fitting a portion of a holding member between the lateral flanges adjacent to an end portion of said section, and striking down portions of the lateral flanges upon the part

of said holding member fitted between the flanges to clamp said holding member to said section. This latter step is entirely new in bracelet manufacture. Heretofore the holding or hinge member was held in place in the bracelet section by soldering and the district court so found (pp. 13, 17). Bellavance conceived and applied to the foregoing steps the idea of supporting the lateral faces of the flanges at points adjacent the struck down portions. This made it possible to swage portions of the flanges onto the holding members or hinge plates. Heretofore, when this form of swaging had been practiced in other arts the metal was thick and strong enough to stand alone and absorb the force of the swaging action. But in bracelets a thin metal is used, hence the method disclosed in the Hiering patent (p. 195) is not applicable to bracelets because it would distort them.

So for many years bracelets were made by millions, and the hinge plates were soldered in place for lack of any method for striking lugs out of the flanges onto said plates that would not deform the bracelet section. Once the new method was invented and applied to bracelets, everybody could see that it was easy to do. That is always true of the greatest inventions. As the U. S. Supreme Court said in *Loom Co. v. Higgins*, 105 U. S. 580, page 591:

“But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not for years occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it, but they certainly failed to see it, to estimate its value, and to bring it into notice. Who was the first to see it, to understand its value, to give it shape and form, to bring it into notice and urge its adoption, is a question to which we shall

shortly give our attention. At this point we are constrained to say that we cannot yield our assent to the arguments, that the combination of the different parts or elements for attaining the object in view was so obvious as to merit no title to invention. Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit."

The laws of mechanics and science remain steadfast. Every thing does just what you would expect it to once you understand it and see how some one else has applied the knowledge. The First Circuit Court of Appeals now says that:

"we have grave difficulty in seeing how it could possibly be said that an exercise of the faculty of invention was required to conceive the idea" (p. 219).

Let us learn from those who were skilled in the art and were actually making bracelets and gained their livelihood therefrom, because these are the skilled journeyman who have the greatest stimulus to find a better way of making bracelets.

That the art was longing for Bellavance's invention and was trying to solve the problem it was confronted with, is evidenced by the large number of prior art patents for bracelets in evidence. First of all we have the finding of the district court that:

"Hargreaves admitted in cross-examination that up to 1937, the common way of attaching the hinge plate to the bracelet was by soldering" (Rec. p. 17).

Who was Hargreaves? He is a bracelet manufacturer, and has been an expert particularly in bracelet manufacture for 35 years (Rec. p. 15). In trying to solve the

problem Hargreaves in 1933 invented and patented a bracelet himself (Rec. p. 179). He failed, for he admitted that the practice was to solder the hinge plate to the bracelet up to 1937 when Bellavance made his invention. Here was a "journeyman" and more, for he was an inventor himself, highly skilled in the art, and devoting his time and talents to the very same problem Bellavance did, namely, to eliminate soldering of the hinge plates to the bracelet sections.

Take the Morrow brothers, two officers of defendant corporation. Both Earl Morrow and his brother Frank Morrow are experts in bracelet manufacture. Earl Morrow devised the Exhibit 2 bracelet in an effort to avoid infringement of the article claims of the patents in suit and sought a patent therefor (Rec. p. 62). Their testimony shows they are fully acquainted with all phases of the manufacture of bracelets, shop practices, etc.

Furthermore, they were under the greatest stimulus to find a way of making a better bracelet because they are the largest bracelet manufacturers in this part of the country at least, and thus had the most to gain by devising a better method to take the place of soldering the hinge plates to the bracelet sections. They were unable to overcome the problem; but did change over to Bellavance's method and adopt his bracelet construction with alacrity immediately upon learning of them.

The statement in the opinion (Rec. pp. 218, 219) that there can be no doubt that the district court found claim 2 invalid is erroneous. There is no indication anywhere that the Court considered the Bellavance method at all. Claim 2 was copied into the lower court's opinion, and thereafter it was never mentioned. There is no discussion whatsoever of the Bellavance method. Nothing is said in the opinion to indicate that the district court judge had it in mind. His closing statement that "the Bellavance and Manickas bracelets are not patentable" shows that he dealt only with the article claims for the bracelets.

To allow a district court judge to ignore the Rules of Civil Procedure as the district court judge has done in this case is to flout them. Those rules were made by the United States Supreme Court and the Circuit Courts of Appeals should uphold them—not permit outright violations of them.

The First Circuit Court in its second opinion frankly states that it and the district court heavily relied upon *Cuno v. Automatic* in concluding that the claims of the plaintiff's patents were invalid for lack of invention (Opinion p. 2). It believes that the Supreme Court in the *Goodyear* case did not recede "from the strict application of the standard for invention established in the *Cuno* case" (Opinion p. 3). This, in its opinion, leaves the law such that if a patent case reaches the Supreme Court to resolve a conflict between decisions of two Circuit Courts the Supreme Court "will apply the standard strictly" (Opinion p. 3). But if the case reaches the Supreme Court merely to review a single decision by a Circuit Court of Appeals, as in the *Goodyear* case, that held a patent valid, it will apply the standard of invention liberally. This is most unfair to a patentee. As the First Circuit Court says in this case (second opinion):

"The situation may be unfortunate in that it leads to the unequal application of the patent law—a relatively trifling contribution may eventually obtain the protection of a patent while a more important one may not, depending upon whether or not there is a conflict of view between circuits—but this is not a problem for us to cope with" (Opinion p. 3).

The First Circuit Court then goes on to say:

"The most that circuit courts of appeals and district courts can do is what we and the court below

have done here, that is, apply to the best of our ability the standard as we think the Supreme Court would apply it if a conflict between circuits should arise and certiorari should for the reason be granted" (Opinion p. 3).

In other words, the allegedly strict standard of the *Cuno* case has been applied to this case rather than the liberal standard of the *Goodyear* case. This leaves the patentee and the courts in a confusing predicament which only the Supreme Court can clear up, and on the question of validity leaves every one in a state of uncertainty which the First Circuit Court describes as

"the confusion in the law with respect to the nature of the question of patentable invention" (Opinion p. 4).

Counsel for petitioner believes that such findings as the existence of prior use, commercial success, the conscious copying of a patented article, et cetera, insofar as they depend upon oral testimony or upon conflicting testimony are findings of fact that are not reversible except for manifest error. But if the evidence is documentary or in the form of records the appellate court is in the same position as the lower court and fully able to draw its own conclusions therefrom unaffected by those of the lower court. See *Amory v. Amherst College*, 229 Mass. 374, 389, 390.

Any inferences or conclusions drawn from findings of fact are subject to review by the Supreme Court and by a Circuit Court of Appeals. The lower court judge is in no better position to draw conclusions from the facts as to validity than higher courts. As stated by Judge Lummus, now of the Massachusetts Supreme Judicial Court, in discussing findings of fact and conclusions of law in the Massachusetts Superior Court Rules, Rule 90, page 288:

"where the master reports the subsidiary facts and then draws a conclusion from them * * * it is the duty of the judge to draw proper inferences from the findings unaffected by the conclusions of the master and the duty of the full court to draw such inferences unaffected by the conclusions of either." *Robinson v. Pero*, 272 Mass. 482, *Brockton v. Lee*, 266 Mass. 550, 562.

In *United States v. Robert Esnault-Pelterie*, 299 U. S. 201, 205, Justice Butler held that decision on the issues of validity and infringement depends upon findings of fact, and that on these issues:

"the findings in order to be sufficient to sustain judgment for plaintiff must specifically decide questions of validity and infringement, and also include circumstantial facts sufficient to warrant the court's conclusion in respect to the main issues."

In cases tried without a jury the court can always review conclusions drawn from findings of fact. This has always been the law. Unless it can an appellate court is practically powerless.

In the instant case the District Court and the Circuit Court of Appeals have found facts which inexorably lead to the conclusion that the claims in suit are valid if the law laid down in the *Goodyear* case is applied.

The Bellavance method in this case, like the Anthony dry cell in the *Goodyear* case was invented in an old art that was devoid of any solution for the difficulties that their inventions overcame. Once the inventions became known they commended themselves to the public as evidenced by their marked commercial success.

The Circuit Court of Appeals concedes in its opinion that the Bellavance method was new, that he was the

first to use the method in bracelet making, and that it is ingenious and a step forward in the art of making bracelets. Where it errs is in holding the patents invalid because a journeyman or workmen should have discovered and done it as a matter of routine. As Justice Roberts said in the *Goodyear* case:

“Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, *but this is not enough to negative invention.*”

Since the Supreme Court has said that even though the invention should have been obvious to the skilled workmen when viewed after the event, “this is not enough to negative invention”. The First Circuit Court should be guided thereby rather than interpreting the *Cuno* case as setting up a different and strict standard of invention which the lower courts should adhere to.

The Article Claims in Suit.

Coming to the Bellavance article claim 1. It is specific to a bracelet structure, and to a certain kind of bracelet structure, which is made of material that cannot be swaged as Hierung swaged. If it were made of material comparable in thickness with that Hierung used to make a bag frame then the court's finding that the arts are sufficiently analogous to one another to negative invention by Bellavance would have more weight (Rec. p. 218). But the situation is not that. The Bellavance bracelet structure is the product of his new “ingenious and a step forward” method. It is restricted to the product of that method in a practical sense. To adequately protect a method invention the article produced thereby, if it is new, should likewise be protected. Such has been the custom.

The Bellavance bracelet is a new one—a product resulting from the creation of his new method.—In all fairness to an inventor who has so advanced the art, patent protection for an article should go along with that for a method if it is possible, and in this case it is because claim 1 is so specific as to structure.

The above also holds true as to the claims of the Manickas patent (p. 123), since Manickas advanced the art by inventing a structure that gives greater strength to the bracelet. It is not asserted that the difference between what Manickas did and what Bellavance did in conceiving his new method are equally great. The step Bellavance took was from infinity to a method because there is no analogous method step in evidence prior thereto. What Manickas did was to extend the existing flanges—not shape them differently as the Court said on page 218 of its Opinion—and to apply his idea to a certain bracelet structure that he claimed.

Public Interest.

In the United States inventors and scientists are our most important citizens. Without them we could not win this war, for enemy nations have successfully stimulated their inventors to improve upon the apparatus and devices of warfare. Scientific workers and inventors are the creators of the improvements in life which we call material progress. Every one benefits from them. The growing hostility of courts toward their patents originally started in decisions against those who abuse the patent monopoly by using invalid patents in attempts to legalize violations of the Sherman-anti-trust Act. But the lower courts, such as the First Circuit Court of Appeals in this case, have now turned against inventors and their patents. They are mutilating the patent statute enacted by Congress and all the law that was developed by the courts under it.

The Government grants inventors a patent monopoly as a reward for inventing and disclosing their inventions. The Constitution authorizes it and Congress has enacted the patent statute, which has not been changed in a material sense for many years. The courts can at least lay down clear laws for these men of progress. If new burdens are to be laid upon their inventions and old protections removed, the law should be the same in every circuit. The basic rules of evidence should be the same throughout the United States on such vital issues as proving patent validity or invalidity. The standard of invention should be the same in all circuits.

Conclusion.

Counsel for plaintiff-petitioner earnestly submits that this Court should order up this case to resolve the confusion in the law; settle upon basic principles of burden of proof in patent law, clear up the question of what standard of invention should be applied to a patent (strict or liberal), whether the ultimate questions of validity and infringement are conclusions of law, findings of fact, or inferences or conclusions from findings of fact and to what extent said ultimate questions are reviewable by Circuit Courts of Appeals.

Respectfully submitted,

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